

## REMARKS

Applicant respectfully requests reconsideration of the instant application on the basis of the following arguments and the accompanying Section 132 declaration of Dr. Ariel Luzzatto. Claims 1 and 20 are the main claims and the remaining claims are directly or indirectly dependent upon those.

The accompanying declaration or other evidence being filed after the final rejection, but before or on the same date of filing an appeal, should be entered since the affidavit or other evidence was made necessary only by the subject Office Action, and thus could not have been earlier presented.

In accordance with M.P.E.P § 714.22, any amendment, reply or other evidence that will place the application either in condition for allowance or in better form for appeal may be entered. The following reply clearly shows that the grounds for rejection are improper, were premature, and should accordingly be removed.

### **35 U.S.C. § 102(b) Grounds for Rejection**

The Examiner has principally rejected the claims as being anticipated by U.S. Patent Number 5,382,970 to Kiefl (*Kiefl*). It is believed that Claims 1 to 24 are clearly distinguishable over this reference for the reasons that will be set forth.

Currently pending Independent Claims 1 and 20 recite the following elements, the most pertinent to this discussion being presented in bold type for the convenience of the Examiner:

1. Method for determining the efficiency of publicity and/or broadcasted programs, which comprises the following steps:

- a) **Providing frequency-determining apparatus located in the proximity of a TV converter or FM radio;**
- b) Periodically determining the current frequency of a broadcast channel;
- c) Transforming said frequency into a digital word and storing same in a memory associated with said frequency-determining apparatus; and,
- d) When a request is received from a remote control center, transmitting a reply which comprises the digital word stored in the memory at the time of said request.

20. Apparatus for collecting data related to the efficiency of publicity and/or broadcasted programs provided to a user via a TV converter or FM radio, comprising:

- i. An optical reader suitable to read the frequency displayed on the TV converter or FM radio and to convert it to a digital value;
- ii. Circuitry for deriving from said frequency a corresponding digital word; and,
- iii. A transceiver suitable to receive said digital word and to transmit it to a specific recipient.

Regarding Claim 1, Applicant respectfully suggests that the Examiner is in error in stating at page 2 of the Office action, that *Kiefl* comprises the step of “**a) Providing frequency-determining apparatus located in the proximity of a TV converter or FM radio**” (col. 8 lines 8-31). *Kiefl* has nothing of the sort, as well explained in the paragraph cited by the Examiner in the subject Office Action. What *Kiefl* does is to receive data on the selected channel from an IR remote control. *Kiefl* does not have a frequency-determining apparatus located in the proximity of a TV converter or FM radio.

Moreover, *Kiefl* does not address radio transmission at all in the mentioned paragraph, since it deals only with the reception of an IR signal, which is only practically applicable to TV sets.

The additional option of inputting the channel information manually (col. 8, lines 27-28) also specifically teaches away the fact that no frequency-determining apparatus is envisaged. Inputting data by hand is not “determining” the frequency.

Additionally, Applicant suggests that the Examiner’s reference in sub-paragraph b) (page 2 of the subject Office Action) is wrong and misleading. The section at Col. 7, lines 50-51 does not refer to the “periodically determining” of the invention. The statement made by *Kiefl* is misleading when read in isolation from the rest of the description. The channel selector 14 (in *Kiefl* Figure 1) belongs to the TV set, while the warning device (in *Kiefl* Figure 5) belongs to the personal data meter. There is no direct interaction between the two.

In fact, *Kiefl* does not perform any direct information exchange with the TV set. The operation of the warning device depends on the action of the viewer on the personal data meter, and is not operated by the TV set. Thus, it does not determine the TV set frequency, and does not perform periodic checks. What the device of *Kiefl* does is to check whether the viewer performed a specific operation on the personal data meter.

Accordingly, the Examiner’s novelty rejection of claim 1 is in error and should be withdrawn.

Finally, regarding the Section 102 rejection of claim 20, the Examiner makes an unreasonable and unsupported inference that an infrared detector is, in his opinion, an “optical reader.” It is not.

The skilled person's understanding of the term "optical reader" involves the recognition of characters. For instance, the definition given to the term by the PC Magazine Encyclopedia ([http://www.pcmag.com/encyclopedia\\_term](http://www.pcmag.com/encyclopedia_term)) is: **"An input device that recognizes typewritten or printed characters and bar codes and converts them into their corresponding digital codes."**

The Free Dictionary (<http://www.thefreedictionary.com>) defines optical character reader as follows: **"(Electronics & Computer Science / Computer Science) a computer peripheral device enabling letters, numbers, or other characters usually printed on paper to be optically scanned and input to a storage device, such as magnetic tape. The device uses the process of optical character recognition Abbreviation (for both reader and recognition) OCR."**

Moreover, referring to an infrared detector as an "optical reader" is inappropriate and misleading. Infrared radiation (IR), which is in fact heat radiation, consists of invisible light, and an infrared detector, such as the ones in use with TV remote controls, consists merely of a single-pixel energy detector with a narrow viewing beam width (few degrees).

Accordingly, the Examiner improperly expanded the definition to cover an IR detector and Applicant requests that the novelty rejection be withdrawn.

### **35 U.S.C. § 103 Grounds for Rejection**

The Examiner has also rejected certain claims under 35 U.S.C. § 103(a) as being unpatentable over the *Kiefl* patent in view of U.S. Patent No. 6,424,816 by Stephens (*Stephens*) and further in view of U.S. Patent No. 6,466,765 by Tanaka *et al.* (*Tanaka*). Applicant respectfully traverses these rejections for the reasons discussed below.

The Examiner finds obviousness in the claims in view of *Kiefl* alone or in combination with other references. However, *Kiefl* cannot be properly combined with any other reference, because *Kiefl* itself teaches away from the present invention, as will be discussed in greater detail below. The matters discussed below are further addressed and support can be found in the attached Rule 132 Declaration of Dr. Ariel Luzzatto.

The main thrust of *Kiefl* is the use of an IR detector to “capture” the signal originating from the TV remote and directed to the TV set. Initially, it should be noted that the invention cannot work with a vehicle radio set, because such radio is not operated using an IR remote, as admitted at col. 8, lines 56-59). Moreover, quite incongruously, although the description uses at times a cellular device to transmit data, *Kiefl* states at col. 9, lines 49-52, that his invention “could omit the cellular telephone module,” which is central to the present invention.

In fact, the IR detection method described in *Kiefl* is rather naïve, and it will likely be difficult to implement it in practice for the following reasons:

1 - In general, it will be very difficult to place the TV set and the personal data meter in a relative position so that both will be able to simultaneously receive the IR signal transmitted by the TV remote control. It is in everyone’s experience that in order to operate IR remote controls, whether on TV sets, air conditioners or others, due to the narrow angles involved in IR devices, one has to carefully point the remote control in the direction of the corresponding receiving device, and even so, often one has to perform several retrials until the operation is successful. Trying to have two IR receivers in different positions to detect simultaneously the same remote control IR beam may turn out to be a very tough task.

2 - The IR detector of different standard TV sets may have different sensitivity as compared to the personal data meter proposed by *Kiefl*, so a specific tweaking procedure will be required for every user, not to mention the fact that as the internal battery of the remote control becomes weaker, a more and more accurate aim is required in order for the TV set to react, thus leading to a performance that is unstable over time.

Accordingly, it is submitted that the skilled person cannot learn anything from *Kiefl*, which could point in the direction of the present invention.

Next, *Kiefl* collects a lot of data regarding the behavior of the viewer (col. 3, lines 11-18) and then calls a preselected number at a preselected time, preferably once a day (see, e.g., col. 6, lines 52-56; col. 4, lines 50-55).

*Kiefl* also cannot poll data via a cellular channel. When it polls data, *Kiefl* teaches to use a land line - see the distinction made by *Kiefl* at col. 4, lines 20-24, between “cellular telephone” and “telephone.”

And, when a radio transmission is involved, there is no option to poll data when desired by the remote collection station.

*Kiefl* further grossly teaches away from the present invention inasmuch as it requires a manual input from the listener, which is not needed according to the present invention. This is clearly stated throughout the specification - see, e.g., col. 3, lines 8-9; col. 3, line 41; col. 4, lines 1-4; col. 8, lines 61-64.

Applicant therefore suggests that the Examiner has applied an improper mosaic or hindsight approach to the invention. When read by a skilled person as a whole, *Kiefl* not only

does not hint in any way at the present invention, but actively misleads and teaches away from it, as further elaborated in the attached Opinion by Dr. Ariel Luzzatto.

It is improper to use hindsight having read the Applicant's disclosure to "pick and choose" among isolated prior art references to disparage the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Even where an invention is, as a whole, fully disclosed by a combination of prior art elements, such elements cannot be combined to defeat a patent as obvious unless the art teaches or suggests the desirability of making the combination. ASC Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984). Thus, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, U.S.P.Q.2d 1780 (Fed. Cir. 1992). Finally, it is the invention as a whole that is important. Focusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness. Gillette Co. v. S. C Johnson & Son, Inc., 919 F. 2d 720, 16 U.S.P.Q. 1923 (Fed. Cir. 1990).

Reconsideration of this proposed combination is respectfully requested because there would be no reason to combine *Kiefl* with the other cited references in this manner since each device is complete and functional in itself and since the devices themselves fail to suggest any such combination or that there would be any advantages in combining their teachings. As was stated in In re Sernaker, 217 U.S.P.Q. 1, 6 (CAFC 1983),

"[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings."

As was further stated in Orthopedic Equipment Co., Inc. v. United States, 217 U.S.P.Q. 193, 199 (CAFC 1983),

“It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims in issue]. Monday morning quarterbacking is quite improper when resolving the question of obviousness in a court of law [here the PTO].”

Accordingly the rejection of the claims on *Kiefl* in view of *Stephens* and *Tanaka* is submitted to have been improper.

In order to establish a prima facie case of obviousness, the prior art teachings must be sufficient to suggest making the substitution or modification necessary to make the claimed invention to one of ordinary skill in the art, In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984), in the absence of applicant’s own disclosure. See also, In re Laskowski, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398-99 (Fed. Cir. 1989) and Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). The motivation to make a specific structure

“is not abstract, but practical, and is always related to the properties or uses one skilled in the art would expect the [structure] to have, if made.”

In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979). See also Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985)(“Critical inquiry is whether ‘there is something in the prior art as a whole to suggest the desirability, and, thus, the obviousness, of making the combination’”).



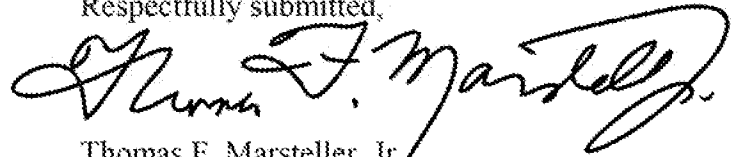
There must have been a reason apparent at the time of the invention was made to a person of ordinary skill in the art for applying the teachings at hand to effect the modification necessary to reach the claimed invention in the manner proposed or the use of the teaching as evidence of obviousness will entail prohibited hindsight. Graham v. John Deere of Kansas City, 383 U.S. 1, 148 USPQ 459 (1966), and In re Nomiya, 509 F.2d 566, 184 USPQ 607 (CCPA 1975).

Here there is lacking the requisite suggestion in these prior art disclosures that would have motivated the artisan to do what the Examiner has characterized as being an obvious combination.

### Conclusion

For all the reasons given above, this application is submitted to contain claims that define a novel, patentable, and truly valuable invention. Hence allowance of this application is respectfully submitted to be proper and is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas F. Marsteller, Jr.", written in a cursive, flowing style.

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